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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/876,812    06/17/97    DOUGLAS

J    018176-070

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BURNS DOANE SWECKER & MATHIS L L P  
POST OFFICE BOX 1404  
ALEXANDRIA VA 22313-1404

EXAMINER

CHIN, C

ART UNIT	PAPER NUMBER
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1641

DATE MAILED:

07/05/01

*LS*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/876,812

Applicant(s)  
Douglas et al

Examiner  
Chris Chin

Art Unit  
1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 1, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 52-83 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 52-83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/4/01 has been entered.

### ***Claim Rejections - 35 U.S.C. § 112***

2. Claim 60 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are directed to a morphology-improving coating which includes conductive and non-conductive materials. Because the specification only discloses non-conductive, morphology-improving material, the claims are now broader than the teachings of the specification. Therefore, claim 60 contains new matter (namely a conductive, morphology-improving material) that is not disclosed in the originally filed specification.

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In response to this rejection, Applicants argue that nothing in 35 U.S.C. 112 requires the claims to correspond to the specific embodiments described in the specification. As a general rule, claims can cover more than the specific embodiments illustrated in the disclosure, if the prior art permits. Applicants assert that 35 U.S.C. 112 first paragraph is still satisfied even if the claims cover more than the preferred embodiments expressly described in the specification. Applicants refer to *In re Smythe*, 480 F.2d 1376, 178 USPQ 279, 284 (CCPA 1973) to support their position.

Applicant's argument has been considered but is not convincing. Applicant's attention is directed to MPEP 706.03(o) which covers new matter situations:

"In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. 112, first paragraph, *Waldemar Link, GmbH & Co. v. Osteonics Corp.* 32 F.3d 556, 559, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981)."

Applicants are correct in stating that the claims do not have to correspond to the specific embodiments disclosed in the specification; however, the claims have to be supported by the originally filed specification. Any limitation(s) recited in amended claims not supported by the originally filed specification are considered new matter, which is the situation in claim 60. Claim 60 has been amended to encompass both conductive and non-conductive materials in the surface morphology-improving coating. The originally filed specification does not disclose the use of any conductive materials in the surface morphology-improving coating. Unless Applicants can point to specific support in the originally filed specification for conductive materials in the surface

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morphology-improving coating, claim 60 should be amended to stipulate that the surface morphology-improving coating is a non-conductive coating.

*Claim Rejections - 35 U.S.C. § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-16 and 52-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diebold et al (U.S. Patent 5,437,999) in view of Ovahinsky et al (U.S. Patent 4,217,374) for the reasons of record.

In response to this rejection Applicants argue on page 13 of the amendment filed on 4/4/01 that Diebold et al fails to teach the instant device by referring to specific portions the specification in Diebold et al.

Applicant's argument has been considered but is not convincing. The office action dated 1/4/01 (paper #20), specifically page 4, set forth the relevant teachings in Diebold et al that read on the instant device absent the teachings relied upon in Ovahinsky et al.

Applicants also argue that Diebold et al fails to teach a single substrate as required in the instant claims.

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Applicant's argument has been considered but is not convincing. While Diebold et al may teach a first insulating substrate and a second insulating substrate, the open "comprising" language of the instant claims do not preclude an additional substrate.

Applicants further argue that the "thin anchor layer" of Diebold et al is not a surface morphology-improving coating.

Applicant's argument has been considered but is not convincing. The thin anchor layer taught by Diebold et al increases the adhesion between the support material and the electrically conducting material. By increasing the adhesion properties of the support material, the anchor layer also improves the surface morphology of the support material. It was also pointed out that Diebold et al also discloses roughening the surface of the support material by deposition of a colloidal catalyst before deposition of the electrically conducting material. The layer of colloidal catalyst is also considered a surface morphology-improving coating.

Applicants further argue that Ovahinsky et al cannot be combined with Diebold et al because Ovahinsky et al teaches applying the amorphous semiconductor material to a conductive surface instead of a non-conductive surface.

Applicant's argument has been considered but is not convincing. Ovahinsky et al teaches that the substrate material can be a metal, a crystalline semiconductor or other material upon which it is desired to form the film of amorphous semiconductor material (see col. 10, lines 27-30). Ovahinsky et al is not limited to only conductive materials in the substrate.

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*Conclusion*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Chin whose telephone number is (703) 308-3991. The examiner can normally be reached on Monday-Thursday from 9:30 am to 7:00 pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

cchin/cc  
June 30, 2001



CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP 1800-1641